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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,002	04/05/2004	Taichi Kobayashi	Q80862	2744

23373 7590 06/23/2006

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

KUGEL, TIMOTHY J

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 06/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/817,002

Applicant(s)

KOBAYASHI ET AL.

Examiner

Timothy J. Kugel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-33 is/are pending in the application.
4a) Of the above claim(s) 7-9,11-25 and 27 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1,2,4-6,10,26 and 28-33 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☒ Claim(s) 1,2 and 4-33 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/5/04.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

1. Claims 1, 2 and 4-33 pending as amended on 15 May 2006, claim 3 being cancelled. Claims 7-9, 11-25 and 27 are withdrawn from further consideration. Please note that claim 27 was inadvertently left off the list of claims withdrawn in the previous Office action.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

3. This application contains claims 7-9, 11-25 and 27 drawn to an invention or species nonelected without traverse. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Information Disclosure Statement

4. Applicant is correct in asserting that the Japanese language references not considered in the previous Office action were correctly submitted as they were referenced on an International Search Report. The references have been fully considered and an initialed and signed copy of the Information Disclosure Statement filed 5 April 2004 is attached to this Office action.

Claim Objections

5. Applicant's amendment, filed 15 May 2006, with respect to the term 'polyolefin' has been fully considered and are corrective.

The objection to claim 31 has been withdrawn.

Claim Rejections - 35 USC § 112

6. Applicant's amendment, filed 15 May 2006, with respect to removal of the terms 'such as', 'e.g.', R acid, G acid, H acid, γ acid, ϵ acid and J acid has been fully considered and is corrective.

The rejection of claims 4-6, 28 and 31 under 35 USC 112 2nd paragraph has been withdrawn.

7. Claim 33 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The inclusion of a term within parentheses—with the exception of parentheses required for chemical nomenclature—renders the claim indefinite because it is unclear whether the included term is part of the claimed invention.

Also, it is unclear what the terms R acid, G acid, H acid, γ acid, ϵ acid and J acid represent.

Double Patenting

8. Applicant's terminal disclaimer, filed 21 March 2006, has been fully considered and is proper.

The provisional rejection of claims 1 and 2 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 4 of copending Application No. 10/696,312 has been withdrawn.

Claim Rejections - 35 USC § 102 and/or 35 USC § 103

9. Applicant's amendment, filed 15 May 2006, with respect to importing the diammonium compound comprising a divalent anion has been fully considered and overcomes the prior art.

The rejection of claims 1, 2, 4, 10, 26, and 28-32 under 35 USC 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as being obvious over US Patent Application 2001/0005278 (Onomichi hereinafter) has been withdrawn.

10. Applicant's filing, on 15 May 2006, of a certified translation of the foreign priority document JAPAN 2001-308849 disqualifies the reference US Patent Application Publication 2005/0040378 (Kobayashi '378 hereinafter) as prior art.

The rejection of claims 1, 2, 4-6, 10 and 28-32 under 35 U.S.C. 102(e) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kobayashi '378 has been withdrawn.

11. Claims 1, 2, 4-6, 10 and 28-32 stand, and new claim 33 is, rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Japanese Patent Publication JP2001-174626 (Kobayashi '626 hereinafter). Please note that Kobayashi '626 is an X-type reference cited on the International Search Report for PCT/JP02/10252 from which the instant application is a continuation.

Kobayashi '626 teaches a near-infrared absorption film comprising a substrate and an infrared absorption layer comprising 0.1 to 10 % diimmonium salt as described in instant claims 1-6 including the elected species in a binder resin that may be a

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homopolymer or a copolymer of polyester resin, acrylic resin, methacrylic resin, urethane resin, silicone resin, phenol resin, polyethylene terephthalate resin, (meth)acrylic acid ester, and the like. (Claim 4, ¶¶ 0016-0018 and 0034-0037).

Since Kobayashi '626 teaches the same composition as claimed, one of ordinary skill in the art at the time the invention was made would have expected that the DSC of the diimmonium salt of the Kobayashi '626 composition would inherently be the same as claimed.

Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. 102 and 103. "There is nothing inconsistent in concurrent rejections for obviousness under 35 U.S.C. 103 and for anticipation under 35 U.S.C. 102." *In re Best*, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA 1977).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent 7018714 (Kobayashi '714 hereinafter).

13. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Kugel whose telephone number is (571) 272-1460. The examiner can normally be reached 6:00 AM – 4:30 PM Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

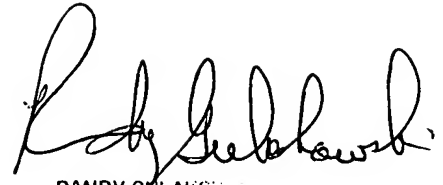
TJK

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A handwritten signature in black ink, appearing to read "Randy Golakowski". The signature is fluid and cursive, with a large initial "R" and "G".

RANDY GOLAKOWSKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700